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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,313	09/26/2001	Martin R. Hodge	MPI1999-016CP1CN1(M)	5742

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EXAMINER
ROARK, JESSICA H

ART UNIT	PAPER NUMBER
1644	

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/965,313	HODGE, MARTIN R.	
	Examiner	Art Unit	
	Jessica H. Roark	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Claims 1-23 are pending.

Restriction Requirement

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-7, 12-13, and 19, drawn to an isolated nucleic acid molecule of SEQ ID NO:1 or SEQ ID NO:3 encoding a polypeptide of SEQ ID NO:2 or SEQ ID NO:4 and variants thereof; vectors, host cells, and methods of producing the polypeptide, classified in Class 536, subclass 23.5; Class 435, subclasses 69.1, 455, 252.3, and 320.1.

II. Claims 8-10, drawn to a polypeptide comprising SEQ ID NO:2 or SEQ ID NO:4, variants thereof, and heterologous proteins comprising said polypeptides; classified in Class 530, subclasses 350 and387.3.

III. Claims 11 and 16, drawn to an antibody and kits comprising; classified in Class 530, subclass 387.3; Class 435, subclass 810.

IV. Claims 14 and 15, drawn to a method of detecting the presence of the polypeptide of SEQ ID NO:2 or SEQ ID NO:4, classified in Class 435, subclass 7.1.

V. Claims 17 and 18, drawn to a method of detecting the presence of the nucleic acid of SEQ ID NO:1 or SEQ ID NO:3, classified in Class 435, subclass 6.

VI. Claims 20-21, drawn to a method of identifying a compound which binds to the polypeptide of SEQ ID NO:2 or SEQ ID NO:4, classified in Class 435, subclass 7.1.

VII. Clam 22, drawn to a method of **stimulating** the activity of a polypeptide of SEQ ID NO:2 or SEQ ID NO:4, classified in Class 514, subclass 885.

VIII. Clam 22, drawn to a method of **inhibiting** the activity of a polypeptide of SEQ ID NO:2 or SEQ ID NO:4, classified in Class 514, subclass 885.

IX. Claim 23, drawn to a method for identifying a compound which modulates the activity of a polypeptide of SEQ ID NO:2 or SEQ ID NO:4, classified in Class 435, subclass 7.1

The inventions are distinct because:

3. Groups I, II, and III are different products. Nucleic acids, polypeptides, and antibodies to the polypeptides differ with respect to their structures and physicochemical properties; therefore each product is patentably distinct.

4. Groups I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product, the protein can be made using an amino acid synthesizer.

5. Groups IV-IX are different methods. Each method differs with respect to ingredients, method steps, and endpoints; therefore, each method is patentably distinct.

6. Groups (I and V) and (III and IV), respectively, are related as product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case the nucleic acid of claim 1 can be used to express the polypeptide, in addition to the method of detecting recited; and the antibody of Group III can be used for affinity purification, in addition to the methods recited.

7. These inventions are distinct for the reasons given above. In addition, they have acquired a separate status in the art as shown by different classification and/or recognized divergent subject matter. Further, even though in some cases the classification is shared, a different field of search would be required based upon the structurally distinct products recited and the various methods of use comprising distinct method steps. Moreover, a prior art search also requires a literature search, which would not be completely co-extensive. It is an undue burden for the examiner to search more than one invention. Therefore restriction for examination purposes as indicated is proper.

Species Election

8. This application contains claims directed to the following patentably distinct species of the claimed Inventions I-IX: wherein the nucleic acid or amino acid sequence is derived from:
A) human (SEQ ID NO:1/SEQ ID NO:2, as appropriate), or
B) mouse (SEQ ID NO:3/SEQ ID NO:4, as appropriate).

These species are distinct because they differ at least in terms of their structure since neither the nucleic acids or polypeptides are of identical sequence; therefore they are patentably distinct. In addition, a search for one species would not encompass a search for the other

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

9. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

10. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Roark whose telephone number is (703) 605-1209. The examiner can normally be reached Monday through Friday from 8:00 AM to 4:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Jessica Roark, Ph.D.
Patent Examiner
Technology Center 1600
September 23, 2003

Phillip Gambel

PHILLIP GAMBEL, PH.D
PRIMARY EXAMINER
TECH CENTER 1600
9/24/03